

REMARKS

The Applicants acknowledge with thanks the withdrawal of various rejections and objections from the previous action.

The amendments to allowed claims 102 and 107, step (b), is to insert an omitted word and improve consistency with the reference to step (a) in each of these claims. These amendments are clerical in nature and raise no new patentability issues.

The Office rejected claims 114, 115, and 117, alleging that they introduce new matter. The Applicants disagree with this analysis, but have canceled these claims without prejudice, solely for purposes of expediting issuance of claims indicated as allowable. Thus, the sole rejection in the case is moot, and the application is believed to be in condition for allowance.

At page 3 of the action the Office indicated (with respect to claims 62, 77, 81, 82, 94, 103, and 104) that “the recitation in the claim preamble relating to the targeting of blood vessels ... has not been given patentable weight because the recitation occurs in the preamble.” The Office reasoned that a preamble is generally not accorded any patentable weight where it merely recites the purpose of the process or intended use, and where the body of the claim does not depend on the preamble for completeness but instead stands alone. The Office further concluded that the claims were nonetheless patentable “because Applicants have amended these claims with limitations reciting ‘bispecific antibody’ or ‘blood vascular endothelial marker antigen’ that are not encompassed by the claims of the ‘777 patent.”

Using the criteria for evaluating preambles specified in the action, it is proper to conclude that the preamble of each one of these claims should be given patentable weight. Notably, in each one of the listed claims, the body of the claim refers back to the preamble. See, e.g., claims 81, 103, and 104 specifying “said mammal” in the body of the claim, referring back to the preamble to provide antecedent basis for completeness. (Other claims say “said mammalian organism” -- also referring back to the preamble.) Thus, the body of the claims at issue does depend on the preamble; and the criteria for giving weight to the preamble (summarized in the action) is satisfied. See, e.g., *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (“A claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects. When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” (Citations omitted.)).

As to the issue of patentability of these seven claims on other grounds, the Applicants agree that all of the claims in question include, in the body of the claim, limitations relating to blood vessel endothelial cells, which distinguish the claims from claims of the '777 patent, although claims 81, 103, and 104 do not explicitly recite "bispecific antibody" or explicitly recite "blood vascular endothelial marker antigen" as stated in the action.

As to all of the claims, Applicants wish to clarify and reiterate that their patentability arguments are as summarized in Applicants' interview summary and set forth in detail in their written submissions of June 24. (See, e.g., Section III of the remarks in that paper.) Analysis of whether claims of the patent "encompass" application claims is not dispositive because, irrespective of whether claims are "encompassed," the claimed subject matter would not have been obvious from the claims of the '777 patent alone or in combination with the prior art. See *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986). See also MPEP §804 ("Domination and double patenting should not be confused. They are two separate issues. One patent or application 'dominates' a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection."). The claims of the '777 patent neither disclose nor suggest targeting blood vessels that express Flt4 to treat cancer, or screening for a condition characterized by blood vessel expression of Flt4.

The Examiner is invited to telephone the undersigned attorney if any issues remain that may be amenable to resolution by telephone.

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Respectfully submitted,

By: /David A. Gass #38,153/
David A. Gass

Registration No.: 38,153
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicants